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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,164	09/02/2003	Keh-Shin F. Cheng	BOC9-2002-0032 (327)	1554

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AKERMAN SENTERFITT  
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EXAMINER
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NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/662,164

Applicant(s)

CHENG ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 22-29 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Response to Election filed 12/01/2006 to the original application filed 09/02/2003. Since Applicant presents no arguments, election is interpreted as without traverse.

Claims 1-8 and 22-29 are presented for examination. Claim 43 is withdrawn from consideration. Claims 1 and 22 have been amended. Claims 9-21 and 30-42 have been cancelled. Claims 1 and 22 are independent claims.

Applicant is required to cancel non-elected claim 43 in the next response to this Office Action.

### **5 U.S.C. § 112, 1<sup>st</sup> paragraph**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

Claims 1-8 and 22-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, since the claimed

invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

As to claims 1 and 22, the newly added the limitation “*generating an audio simulation of said displayed image being affixed to the at least one electronic document when the displayed image is move adjacent to or over another image within the user interface representative of the at least one electronic document*” which is not specified in the specification. The Applicant is requested to point to specific of the main body of the specification and sections of the drawing to describe this limitation or lack there of.

As to claims 2-21 and 23-29 are rejected for fully incorporating the deficiencies of their base claims.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later*

*invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 1-8 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagaham (US Patent No. 5948103, issued 09/07/1999) in view of **Milsted et al.** (US 6263313, filed 07/2001).

**As to claims 1 and 22:**

Nagaham teaches a method and a machine readable storage for storing electronic documents (*see Abstract*) comprising

- associating an associative object with at least one electronic document (*col. 1, line 65-col. 2, line 7; col. 7, lines 16-54; col. 12, lines 8-16*), wherein the associative object uniquely corresponds to an image of a seal, stamp, or tape that is visually displayable within a user interface; displaying the image within the user interface (*e.g., a seal image is displayed on the screen when the position pointing device which comes in a shape of a seal stamp, having the encoded data of the document reflected in a slightly blurred seal image; col. 5, lines 10-16*);
- moving the displayed image within the user interface as the associative object is associated with the at least one electronic document so as to visually simulate the image being affixed to the at least one electronic document (*col. 6, lines 34-44; col. 7, lines 9-46; col. 15, lines 28-58; and col. 17, lines 31-53*);
- the displayed image being affixed to the at least one electronic document when the displayed image is moved adjacent to or over another image within the user

interface representative of the at least one electronic document (*col. 12, lines 26-36; col. 13, lines 7-52; and col. 14, lines 33-42*).

- storing at least one metadata attribute as a characteristic related to the associated object (*col. 7, lines 29- 62; col. 19, lines 38-48; and col. 20, lines 8-64*); and
- modifying a storage characteristic of the at least one electronic document based on one of the metadata attributes (*see Abstract; col. 8, lines 57-64; col. 9, lines 30-47; and col. 20, lines 7-29*).

Nagaham does not specifically teach generating an audio simulation.

Milsted teaches generating an audio simulation (*col. 3, line 38-col. 4, line 42; col. 50, lines 26-44; col. 52, lines 20-51; col. 53, line 3- 26; col. 54, lines 10-44; col. 56, lines 16-23; and col. 74, line 47-75, line 21*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nagaham with Milsted because Milsted's teaching would have provided the capability for tracking usage of digital content on user devices as well as information is transmitted to a logging site whenever the content data is played by the content player or copied from the content player to an external medium so that usage of the licensed content data can be tracked.

**As to claims 2 and 23:**

Nagaham teaches a digital seal (*e.g., an electronic seal stamp; col. 5, lines 32-33 and 37-38*).

**As to claims 3 and 24:**

Nagaham teaches presenting at least one multimedia object within the user interface, wherein the multimedia object is a user selectable representation for the associative object (*e.g., audio, multimedia; col. 2, lines 51-54*).

**As to claims 4 and 25:**

Nagaham teaches requiring an authorization code previously specified within one of the metadata attributes before allowing the at least one electronic document to be retrieved (*see Abstract; col. 1, lines 38-42; col. 5, lines 14-16*).

**As to claims 5 and 26:**

Milsted teaches the authorization code is valid for a first user and wherein the authorization code is invalid for a second user (*col. 23, lines 3-60; and col. 44, line 35-col.45, line 2*)

**As to claims 6 and 27:**

Nagaham teaches associating a second associative object with one of the at least one electronic document (*col. 2, lines 29-67*).

**As to claims 7 and 28:**

Milsted teaches wherein the associative object includes an authorization code, and wherein the second associative object includes a second authorization code, the method further comprising the step of: requiring the first authorization code and the second authorization code before the one of at least one electronic document can be retrieved. *(col.9, line 16-col10, line 57).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nagaham with Milsted because Milsted's teaching would have provided the capability for tracking usage of digital content on user devices as well as information is transmitted to a logging site whenever the content data is played by the content player or copied from the content player to an external medium so that usage of the licensed content data can be tracked.

**As to claims 8 and 29:**

Milsted teaches establishing a first authorization code for the associative object, wherein the first authorization code is associated with a first image; encoding the at least one associated electronic documents with a second authorization code associated with a second image; and, decoding the at least one associated electronic documents using at least in part the first image *(col. 9, line 16-col10, line 57).*



It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Nagaham with Milsted because Milsted's teaching would have provided the capability for tracking usage of digital content on user devices as well as information is transmitted to a logging site whenever the content data is played by the content player or copied from the content player to an external medium so that usage of the licensed content data can be tracked.

### **Response to Arguments**

4. Applicant's arguments filed 12/01/2006 have been fully considered but are deemed to be moot in view of the new grounds of rejection necessitated by Applicant's amendments.

### **Conclusion**

5. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Contact information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner for patents

P.O. Box 1450

Alexandria, VA 22313-1450

MN

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**